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EXAMINER

WANG, JIN CHENG

ART UNIT

PAPER NUMBER

2628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/775,710

Applicant(s)

AGRAWALA ET AL.

Examiner

Jin-Cheng Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/1/04 &amp; 10/24/05</u> | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 1-20:**

Claim 1 applies a computer program in the form of a seemingly patentable apparatus, however, claim 1 in reality seeks patent protection for the computer program. Computer program per se is neither computer components nor statutory process. Thus, claim 1 is non-statutory.

Additionally, since claim 1 includes a 101 judicial exception, claim 1 must be for a practical application of the judicial exception. As is, claim 1 failed to recite either a physical transformation or produces a useful and tangible result. Thus, claim 1 is also non-statutory for this reason.

Claims 1-13 and 20 are non-statutory for the same reasons discussed above.

Claims 14-19 are the parallel method claims and are non-statutory for the same reasons discussed above.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

For example, the claim 1 recites “zoomable inking region”. It is not ascertained whether it refers to the zoom window or the zoom origin (See Page 20 of applicant’s specification) or both. Moreover, the claim language “dynamically adjusts a size and a shape of the zoomable inking region while a user annotates the digital document” is not supported by the specification. In a non-limiting example at Page 20 of applicant’s specification, the user taps at the zoom origin and a zoom window is generated wherein the zoom window can be variously shaped and positioned, depending on the properties utilized during generation. This passage does not show “dynamically” as opposed to fixed zoom window. Moreover, applicant’s specification at Page 20 stated that the document information displayed within the zoom window is scaled upon to allow the user to comfortably add annotations similar in size to the document information. This passage shows that the size of the zoom window corresponds to the document information which is fixed after the annotation was made. Clarification is required as to the term “dynamically” and “while” set forth in the claim 1. Thus, this passage does not

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support “dynamically adjusts...the zoomable inking region while a user annotates the digital document.” For the same reasons discussed above, the claim 14 recites “automatically navigating the zoom window while annotating the document.” The zoom window is created while annotating the document, but is navigated after the document is annotated. It is not ascertained from applicant’s specification as to the claim limitation of “automatically navigating the zoom window while annotating the document. Clarification is required as to the term “dynamically” and “while” set forth in the claim 13. The claim 20 recites “dynamically adjusting the annotation window concurrently with annotating the electronic document.” The claim 20 is subject to the same rationale of rejection set forth in the claim 1. Clarification is required as to the term “dynamically” and “concurrently” set forth in the claim 20.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim 1 recites “zoomable inking region”. It is not clear whether it refers to the zoom window or the zoom origin (See Page 20 of applicant’s specification) or both. Moreover, it is not clear what is meant by “dynamically adjusts a size and a shape of the zoomable inking region while a user annotates the digital document”. From Page 20 of applicant’s specification, the user taps at the zoom origin and a zoom window is

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generated wherein the zoom window can be variously shaped and positioned, depending on the properties utilized during generation. This passage does not show “dynamically” as opposed to fixed zoom window. Moreover, applicant’s specification at Page 20 stated that the document information displayed within the zoom window is scaled upon to allow the user to comfortably add annotations similar in size to the document information. This passage shows that the size of the zoom window corresponds to the document information which is fixed after the annotation was made. Clarification is required as to the term “dynamically” and “while” set forth in the claim 1. Thus, this passage does not support “dynamically adjusts...the zoomable inking region while a user annotates the digital document.” For the same reasons discussed above, the claim 14 recites “automatically navigating the zoom window while annotating the document.” The zoom window is created while annotating the document, but is navigated after the document is annotated. It is not ascertained from applicant’s specification as to the claim limitation of “automatically navigating the zoom window while annotating the document. Clarification is required as to the term “dynamically” and “while” set forth in the claim 13. The claim 20 recites “dynamically adjusting the annotation window concurrently with annotating the electronic document.” The claim 20 is subject to the same rationale of rejection set forth in the claim 1. Clarification is required as to the term “dynamically” and “concurrently” set forth in the claim 20.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. U.S. Patent Application Publication 2003/0070139 (hereinafter Marshall) in view of Nagae U.S. Patent No. 6,230,169 (hereinafter Nagae).

Re Claims 1, 14 and 20:

Marshall discloses a system that facilitates free form digital inking (e.g., Figs. 2-6), comprising:

An annotation management component (Figs. 7-10) that generates a zoomable inking region for a digital document (See Figs. 2-6 wherein at least an inking region is generated and zoomed); and

A navigation component (Figs. 7-10) that dynamically adjusts a size and a shape of the zoomable inking region while a user annotates the digital document (*The user annotates the document to produce annotations such as the high-value annotations associated with the asterisk icons 510, 520 and 530 and the size and shape of the zoomable inking region dynamically depend upon the annotations highlighted/encircled/underlined by the emphasis determination circuit or routine while the user annotates the digital document; see Paragraph 0065 and 0074 for the annotation types including highlighting, encircling and underlining by the ink strokes over the annotated document. See Fig. 6 and Paragraph 0055 for the zoomable inking region wherein the zoomable inking region is stored in a memory and is displayed by a call-up 540 associated with the annotation associated with the asterisk 530 in an expanded view while maintaining the reader's orientation of the document 500. It is*

*noted that the size of shape of the call-up associated with other annotations are dynamically dependent on the size and shape of the portions or passages of the document that have been annotated with the annotations, e.g., the annotations associated with the asterisk icon 510 and the asterisk icon 520).*

Marshall is silent to an annotation window in his system for freeform annotation using digital inking.

Nagae teaches the annotation window. Moreover, Nagae discloses a system that facilitates free form digital inking (e.g., Figs. 12, 13, 16A-16B, 17A-17C and 18), comprising:

An annotation management component that generates a zoomable inking region for a digital document (*Figs. 12, 13, 16A-16B, 17A-17C and 18 wherein the zoomable inking region is generated for the digital document; see column 7, lines 1-22 wherein Nagae discloses that the user adjusts the annotation window with a pen wherein the window can be enlarged or reduced. Moreover, the annotation image magnification change section reduces or enlarges the annotation display image of the annotation input window on which the annotation has been written and creates an annotation display image with the changed magnification*); and

A navigation component that dynamically adjusts a size and a shape of the zoomable inking region while a user annotates the digital document (*See Figs. 17A-17D wherein the inking region is dynamically adjusted while a user annotates the digital document; see column 8, lines 40-45 wherein Nagae discloses annotating the digital document by a total number of N annotations similar to the annotations displayed in Figs. 17a-17D; Figs. 12, 13, 16A-16B, 17A-17C and 18 wherein the zoomable inking*



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*region is generated for the digital document; see column 7, lines 1-22 wherein Nagae discloses that the user adjusts the annotation window with a pen wherein the window can be enlarged or reduced. Moreover, the annotation image magnification change section reduces or enlarges the annotation display image of the annotation input window on which the annotation has been written and creates an annotation display image with the changed magnification).*

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to have incorporated Nagae's annotation window into Marshall's system because such annotation window, if incorporated into Marshall annotation system, allows the zoomable inking region to be enlarged or reduced dynamically by the user through the pen or cursor. One of the ordinary skill in the art would have been motivated to do so to allow the annotations to be made on the zoomable inking region on the annotation window as taught by Nagae in Figs. 17a-17D (See also Nagae Figs. 11-12 and column 12, lines 20-32).

Claim 2:

The claim 2 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the annotation management component is invoked to generate the zoomable inking region by identifying a point of interest on the digital document by at least one of a manual and an automatic technique. However, Marshall further discloses the claim limitation that the annotation management component is invoked to generate the zoomable inking region by identifying a point of interest on the digital document by at least one of a manual and an automatic technique (See Figs. 2-6 of Marshall wherein the annotation can be made on the digital document by

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highlighting/underlining etc. the portions or passages of the digital document and the zoomable inking region are correspondingly generated by identifying a point of interest such as identifying a call-up 540 on the asterisk 530 to display an expanded view of the third high-value annotation).

Claim 4:

The claim 4 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the zoomable inking region is generated to cover a subset of the digital document such that the remaining document can be concurrently viewed.

However, Marshall further discloses the claim limitation that the zoomable inking region is generated to cover a subset of the digital document such that the remaining document can be concurrently viewed (Fig. 6).

Re Claims 5 and 19:

The claim 5 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the zoomable inking region magnifies the portion of the digital document within the zoomable inking region.

However, Marshall further discloses the claim limitation that the zoomable inking region magnifies the portion of the digital document within the zoomable inking region (Fig. 6 wherein the expanded view in the region 540 magnifies the portion or passage of the digital document within the zoomable inking region).

The claim 19 is subject to the same rationale of rejection set forth in the claim 5.

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Claim 6:

The claim 6 encompasses the same scope of invention as that of the claim 5 except additional claim limitation that the magnification factor is defined such that the user inks at a similar size to document information.

However, Marshall further discloses the claim limitation that the magnification factor is defined such that the user inks at a similar size to document information (Fig. 6 clearly shows the claim limitation in the ink region 540).

Re Claims 7 and 16:

The claim 7 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein the zoomable inking region is closed via one of a digital pen, a mouse, a button and voice activation.

However, Marshall and Nagae further discloses the claim limitation wherein the zoomable inking region is closed via one of a digital pen, a mouse, a button and voice activation (*Marshall Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1, lines 20-30 disclosing the close down is taught by the prior art; Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed wherein Nagae*

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*inherently teaches erasing/closing the window through the graphical user interface using a mouse).*

The claim 16 is subject to the same rationale of rejection set forth in the claim 7.

Re Claims 8 and 15:

The claim 8 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein inking within the zoomable inking region scales down to a size similar to the text within the digital document when the zoomable inking region is closed.

However, Marshall and Nagae further discloses the claim limitation wherein inking within the zoomable inking region scales down to a size similar to the text within the digital document when the zoomable inking region is closed (*Marshall Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1, lines 20-30 disclosing the close down is taught by the prior art; Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed wherein Nagae inherently teaches erasing/closing the window through the graphical user interface using a mouse).*

The claim 15 is subject to the same rationale of rejection set forth in the claim 8.

Claim 9:

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The claim 9 encompasses the same scope of invention as that of the claim 1 except additional claim limitation wherein the navigation component employs one or more of a move zoomable inking region, a move digital document and a create space technique to navigate through the digital document.

However, Marshall and Nagae further discloses the claim limitation wherein the navigation component employs one or more of a move zoomable inking region, a move digital document and a create space technique to navigate through the digital document (Marshall Fig. 6 employs the move zoomable inking region. Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1, lines 20-30. *Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed*).

Re Claims 10-12:

The claim 10 encompasses the same scope of invention as that of the claim 9 except additional claim limitation the move zoomable inking region, move digital document and create space techniques are based on a space-scale framework.

However, Marshall and Nagae further discloses the claim limitation the move zoomable inking region, move digital document and create space techniques are based on a space-scale framework (Marshall Fig. 6 employs the move zoomable inking region. Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to

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the original text within the digital document; Nagae column 1, lines 20-30. *Nagae also taught in column 1-2 changing the size of the annotation display image on the text display screen wherein the user can reduce the size of the annotation display image substantially to make a display as if the conventional annotation mark were displayed and by the user's operation, all of the annotation display image or only the user-specified annotation display image on the text display screen may be erased/closed).*

The claims 11-12 are subject to the same rationale of rejection set forth in the claim 10.

Re Claims 13 and 18:

The claim 13 encompasses the same scope of invention as that of the claim 1 except additional claim limitation an orientation of the zoomable inking region is determined via moving a digital pen across the document in one of a right-to-left, a left-to-right, a top-to-bottom, and a bottom-to-top manner.

However, Marshall and Nagae further discloses the claim limitation an orientation of the zoomable inking region is determined via moving a digital pen across the document in one of a right-to-left, a left-to-right, a top-to-bottom, and a bottom-to-top manner (Marshall Fig. 6 and Paragraph 0064 employs the move zoomable inking region by moving the pen. Paragraph 0041, 0066 disclosing the fading out of the ink annotation to a size similar to the original text within the digital document; Nagae column 1-2).

The claim 18 is subject to the same rationale of rejection set forth in the claim 13.

Claim 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall et al. U.S. Patent Application Publication 2003/0070139 (hereinafter Marshall)

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in view of Nagae U.S. Patent No. 6,230,169 (hereinafter Nagae) and N. O. Bouvin et al., "Fluid Annotations Through Open Hypermedia: Using and Extending Emerging Web Standards", **Proceedings of the 11th international conference on World Wide Web**, May 7-11, 2002, Honolulu, Hawaii, Pages 160-171 (hereinafter Bouvin).

Claim 3:

The claim 3 encompasses the same scope of invention as that of the claim 1 except additional claim limitation that the zoomable inking region is generated in connection with animation that makes it appear the zoomable inking region grows out of the digital document.

Marshall and Nagae are silent to the claim limitation that the zoomable inking region is generated in connection with animation that makes it appear the zoomable inking region grows out of the digital document.

However, Bouvin discloses the claim limitation that the zoomable inking region is generated in connection with animation that makes it appear the zoomable inking region grows out of the digital document (See Fig. 2 in Page 162 wherein the smooth gloss animation associated with an annotation is displayed).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to have incorporated Bouvin's animation into Marshall and Nagae's system because Marshall has taught the embedded expanded view of the annotated portions of the digital document and such expanded view may be animated using the smooth gloss animation of Bouvin.

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One of the ordinary skill in the art would have been motivated to provide the smooth gloss animation for the annotated portion or passage of the document (See Bouvin Fig. 2 in Page 162).

The claim 17 is subject to the same rationale of rejection set forth in the claim 3.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jin-Cheng Wang whose telephone number is (571) 272-7665. The examiner can normally be reached on 8:00 - 6:30 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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jcw

*Linley*